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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057941
Party	Defendant Barnaby Heating & Air
Correspondence Address	BARNABY HEATING & AIR 4620 INDUSTRIAL ST STE C ROWLETT, TX 75088 UNITED STATES jcelum@celumlaw.com
Submission	Reply in Support of Motion
Filer's Name	JULIE CELUM GARRIGUE
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Signature	/julie celum garrigue/
Date	11/18/2014
Attachments	11.18.2014 RESPONDENT'S REPLY BRIEF.pdf(3363997 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CLOCKWORK IP, LLC	§	Mark: COMFORTCLUB
	§	
Petitioner	§	
	§	Cancellation No. 92057941
v.	§	In re Registration No. 3,618,331
	§	
BARNABY HEATING & AIR, LLC	§	
	§	
Respondent.	§	

**RESPONDENT’S REPLY BRIEF TO PETITIONER’S OPPOSITION
TO MOTION TO JOIN ASSIGNEE AND REOPEN DISCOVERY**

Respondent Barnaby Heating & Air, LLC, (“Barnaby”), by and through its undersigned counsel, files this Reply Brief to Petitioner’s Opposition to Motion to Join Assignee and Reopen Discovery, and further moves and replies as follows:

1. As of September 30, 2014, Assignee, McAfee Heating & Air Conditioning Co., Inc. (“McAfee”), is the owner of the federal trademark for COMFORTCLUB, Registration No. 3,618,331, and is a “required party” to these proceedings and must be joined. *See* FED. R. CIV. P. 19. This inter partes cancellation proceeding is governed by the Federal Rules of Civil Procedure and Federal Rule of Civil Procedure 19(a)(1) defines a “required party” as:

A person who is subject to service of process and whose **joinder** will not deprive the court of subject-matter jurisdiction must be joined as a party if:

- (A) in that person's absence, the court cannot accord complete relief among existing parties; or
- (B) that person claims an interest relating to the subject of the action and is so situated that disposing of the action in the person's absence may:
 - (i) as a practical matter impair or impede the person's ability to protect the interest; or
 - (ii) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because

of the *interest*.

FED. R. CIV. P. 19(a)(1); *see* 37 C.F.R. §2.116(a). If Assignee is not joined in this proceeding, Assignee will be forced to file a concurrent proceeding with the Trademark Trial and Appeal Board, or in Federal Court, to protect its ownership interest in the COMFORTCLUB federal trademark registration.

2. In violation of Federal Rule of Civil Procedure 11(b), Petitioner has made several gross misrepresentations to this Board in its Objection and Brief in Opposition to Respondent's Motion to Join Assignee and Reopen Discovery, namely: (1) that Respondent is an exclusive licensee of the subject, COMFORTCLUB, trademark (Petitioner's Opp., at para. III. B., p. 7); (2) that the "assignment of the subject registration may be a sham and potentially bad faith attempt to reopen the discovery period" (Petitioner's Opp. at paras. I. and III. A., pp. 1, 5-6); (3) that Respondent has a history of failing to respond to TTAB deadlines (Petitioner's Opp. at para. I., p. 1); and (4) that Petitioner supplied Respondent with documents or evidence to support its claims against Respondent (Petitioner's Opp. at para. I, p. 2.). Given Petitioner's direct violation of the federal rules of procedure and its dishonesty, in lieu of sanctions, Petitioner's opposition should be denied in its entirety and Respondent's motion should be granted in its entirety.

3. Respondent is not an exclusive licensee of the COMFORTCLUB mark and Respondent does not "stand in McAfee's shoes." Petitioner's Opposition at para. III. B., p. 7. As is clearly set forth in the Trademark License Agreement, that Petitioner admits was previously produced by Respondent in this case, Respondent is licensed to use the COMFORTCLUB mark "exclusively" within a 90-mile radius of Dallas, Texas. A territorial grant/restriction by McAfee for the licensed use of the COMFORTCLUB mark to Respondent is wholly different than operating under an "exclusive license", as Petitioner represents to this Board in its opposition. McAfee is the exclusive owner of the COMFORTCLUB mark and, as such, must be joined in this

proceeding.

4. Petitioner's claims that the subject Assignment of the COMFORTCLUB trademark is a "sham" and a "bad faith attempt to reopen the discovery period" are untruthful. Petitioner filed this cancellation proceeding on September 22, 2013, in part, to thwart Respondent's assignment of the COMFORTCLUB mark to McAfee. The truth is that in September 2013, counsel for Petitioner and counsel for Respondent discussed in great detail the assignment of the COMFORTCLUB mark from Respondent to McAfee, as evidenced by correspondence from Sean Collin, as counsel for Petitioner, to Julie Celum Garrigue, as counsel for Respondent, that Petitioner would take all necessary steps to stop the COMFORTCLUB mark from being sold to a third party. Exhibit A, Correspondence from Sean Collin for Clockwork IP to Julie Celum Garrigue for Barnaby Heating & Air, dated September 16, 2013. In September 2013, after Petitioner learned that Respondent was negotiating an assignment with McAfee, and after Respondent refused to assign its federal trademark registration of the COMFORTCLUB mark to Petitioner, Petitioner filed the present cancellation proceeding against Respondent. Following the initiation of the cancellation proceeding by Petitioner, and through no fault of Respondent's, negotiations between Respondent and McAfee ceased. Respondent speculates that McAfee was hesitant to become embroiled in the litigation initiated by Petitioner.

In August 2014, following the close of the discovery period in this case, negotiations for the assignment from Respondent to McAfee were reignited, the assignment was finalized on September 30, 2014, and it was recorded posthaste. Petitioner has known of the existence of negotiations between Respondent and McAfee of the subject assignment for over 12 months. Petitioner is also acutely aware that the most recent negotiations for the assignment between Respondent and McAfee began again following the receipt of correspondence from Petitioner to

McAfee dated August 8, 2104. Exhibit B, Correspondence from Direct Energy, a Clockwork IP, LLC subsidiary, to Rohl Air, Plumbing & Heating, dated August 8, 2014. For Petitioner to represent to this Board that the assignment of this registration by Respondent to McAfee is either “a sham”, a “bad faith attempt to reopen discovery”, or a “red herring” is an outright distortion of the truth by Petitioner to this Board. *See* Petitioner’s Opposition at paras. I. and III. A., pp. 1, 5-7.

5. Petitioner argues against the reopening of discovery alleging that Respondent has failed to demonstrate excusable neglect and that Petitioner will be prejudiced by engaging in discovery. Petitioner’s Opposition at pp. 5-7. As set forth in paragraph 4. above, the continued negotiations of the assignment between Respondent and McAfee commenced following the close of discovery. In fact, it was Petitioner’s August 8, 2014 correspondence to McAfee’s franchisee, which threatened to sue said franchisee for the continued use of the COMFORTCLUB mark, which sparked the continued negotiations of the assignment between McAfee and Respondent. *See Exhibit B*. As a result of those continued negotiations, the assignment between Respondent and McAfee was finalized and executed on September 30, 2014. Respondent had no control over any delay in moving to join McAfee in this proceeding following the close of discovery, which resulted in the need to reopen discovery. If Petitioner genuinely seeks to avoid wasting time and money pursuing the COMFORTCLUB trademark registration, McAfee should be joined and discovery reopened.

6. Petitioner also argues that to reopen discovery would potentially have a negative impact on judicial proceedings and create a conflict with the Board’s interest in expedient adjudication of disputes. *See* Petitioner’s Opposition at p. 7. However, the practical application of Petitioner’s arguments regarding the negative impact on judicial proceedings to the facts of this case, overwhelmingly support the grant of joinder and the grant of additional discovery. Without

joining McAfee and allowing discovery to occur, should Petitioner succeed in its current cancellation proceeding against Respondent, McAfee's claims to the COMFORTCLUB mark will remain outstanding. As set forth above, McAfee would then be forced to either file an opposition/cancellation proceeding against Petitioner, or seek relief for its remaining claims in the COMFORTCLUB mark against Petitioner in federal court, resulting in the prolonged adjudication of the dispute involving the COMFORTCLUB federal trademark registration. By that same token, joining McAfee in the current proceeding while refusing to reopen discovery, would render McAfee handicap, and prevent McAfee from meaningfully participating in these proceedings, which would also force McAfee to seek relief from an alternate tribunal. Given the facts, and in keeping with the Board's usual practice, Respondent moves for the joinder of McAfee and further moves for the reopening of discovery so that this case may be decided on what the facts reveal, versus what Petitioner seeks to conceal.

7. WHEREFORE, Respondent, Barnaby Heating & Air, LLC, respectfully requests that the Board:

- a. GRANT Respondent's Motion to Join Assignee;
- b. Enter an Order finding that Assignee, McAfee Heating & Air, Conditioning Co., Inc., be joined in this cancellation proceeding;
- c. GRANT Respondent's Motion to Reopen Discovery and Extend the Trial Setting;
- d. Order discovery be reopened and the trial setting extended; and
- e. An award to Barnaby Heating & Air, LLC of such other and further relief as the Board deems just and appropriate.

Dated: November 18, 2014

Respectfully submitted,

Celum Law Firm, PLLC

//s//Julie Celum Garrigue
JULIE CELUM GARRIGUE

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Counsel for Respondent,
Barnaby Heating & Air, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true copy of **RESPONDENT'S REPLY BRIEF TO PETITIONER'S OBJECTION AND BRIEF IN OPPOSITION TO THE MOTION TO JOIN ASSIGNEE AND MOTION TO REOPEN DISCOVERY** was served on counsel for Petitioner and counsel for Assignee, this 18th day of November 2014, by filing electronically via the ESTTA and by email to:

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Counsel for Petitioner,
Clockwork IP, LLC

Counsel for Assignee,
McAfee Heating & Air Conditioning Co., Inc.

//s// Julie Celum Garrigue
JULIE CELUM GARRIGUE

From: sean collin sc@ipwatch.com
Subject: FW: Clockwork-Barnaby Matter For Settlement Purposes Only, Not Admissible For Any Purpose
Date: September 19, 2013 at 10:39 AM
To: jcelum@celumlaw.com

Dear Julie:

I have not heard from you regarding the attached and my Client is most concerned. They will take all necessary steps to stop their valuable mark being sold to a third party.

Please contact me to set up a time to speak this week. Based on the facts my Client has provided attached hereto, this matter should be very simple to resolve at this point.

Best regards.

Sean

From: sean collin
Sent: Monday, September 16, 2013 10:22 AM
To: jcelum@celumlaw.com
Subject: FW: Clockwork-Barnaby Matter For Settlement Purposes Only, Not Admissible For Any Purpose

Dear Julie:

Please see the attached letter and materials that also went out by mail.

We look forward to the prompt and amicable resolution of this matter between our respective clients.

Please let me know when might be a good time this week to discuss the attached.

Best regards.

Sean



9.13.2013 Comfort Club
Matter.pdf



Club membership card number _____



COMFORT CLUB™

As a One Hour Comfort Club member, you will receive:

BENEFITS

- A. One precision tune-up, professional cleaning, and rejuvenation of your air conditioner PLUS, one Safety Check annually (early spring to summer).**
- B. One precision tune-up, professional cleaning, and rejuvenation of your furnace PLUS one Safety Check annually (early fall to winter).**
- 1. LIFESPAN.** Your system can last up to twice as long. It's like getting TWO air conditioners and TWO furnaces for the price of one. The annual service you receive as part of your Comfort Club membership can double the remaining life of your air conditioner and furnace.
- 2. SAVE \$ and SAVE THE EARTH.** Your savings on utility bills can easily pay for annual service. It's the closest thing to a guaranteed profit investment. "Residential cooling & heating systems are the #1 users of electricity and gas in America. What if everyone used less energy without sacrificing comfort? Shouldn't we do it?" Darren Dixon
- 3. BREAKDOWN-FREE GUARANTEE.** One Hour annual service reduces breakdowns so much, we guarantee that if your furnace or air conditioner needs repairs while you are a Comfort Club member, the next six months membership is FREE. Two visits per year.
- 4. PREMIER CLIENT REWARDS.** As a Comfort Club member, you enjoy special privileges. If you ever need service, you immediately go to the front of the line when setting your appointment.

NAME _____ E-MAIL _____

EXHIBIT A

LOCATION
OF EQUIPMENT

PHONE

[illegible]

TERMS

OPTION A. Monthly Investment \$ _____. Automatic Credit Card Debit. I understand that the monthly fee will continue until a written notice of termination is received at the local office. Allow up to two weeks for termination processing. Method of payment: (Please complete and sign) ☐ Visa ☐ MasterCard ☐ Amex ☐ Discover

Account #																					Card Expiration date: mo. _____ yr. _____
-----------	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	--	---

Representative _____ Date _____

Client Signature: _____ Date: _____

OPTION B: Invest in advance and save: 1 YEAR _____ 2 YEARS _____ 3 YEARS _____
☐ Visa ☐ Mastercard ☐ Amex ☐ Discover Investment \$ _____

Representative _____ Date _____

Client Signature _____ Date _____

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If you're not satisfied,
for any reason, your prior
six months membership
investment will be refunded.
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(508) 555-1212





August 8, 2014

Mr. Jay Rol
Rol Air, Plumbing, and Heating
7510 Lannon Avenue NE
Albertville, MN 55301

Re: COMFORT CLUB Trademark Infringement

Dear Mr. Rol,

The COMFORT CLUB mark is a trademark of Clockwork IP, LLC, ("Clockwork"), one of the Direct Energy group of companies. Clockwork has an extensive portfolio of proprietary intellectual property surrounding our products and services. Clockwork is concerned to ensure all of its products and services are appropriately, and legally, referenced in the media and in any and all advertising of any nature whatsoever.

Recently, we have become aware that you are using Clockwork's COMFORT CLUB mark without authorization. Evidence of your unauthorized use of our intellectual property is attached hereto as Attachment A to this letter. You are not currently authorized to use our COMFORT CLUB mark in any manner.

Your unauthorized use of our intellectual property is likely to cause consumer confusion and to cause consumers to falsely believe you are authorized to use our COMFORT CLUB mark and are affiliated with Clockwork or Direct Energy or our brands when, in fact, no such authorization or affiliation exists. Such consumer confusion may impact consumers' purchasing decisions and may also adversely impact them. Furthermore, your misuse of our intellectual property negatively impacts Clockwork and undermines the considerable time and resources we have expended in developing and marketing our brand.

We are writing to provide you with an opportunity to remove our COMFORT CLUB mark from your website, www.rolairrepair.com, and to comply with the law and with our legal rights without having to incur the costs and liabilities associated with a lawsuit. To comply, you must immediately cease and desist your misuse of our intellectual property. This requires you to remove our mark from your website, in any other advertising, truck wraps, brochures, videos or from any other use or form.

Please respond in writing within fourteen (14) days of the date of this letter to confirm your intent to comply with the law and to respect our legal rights. In the interim, Clockwork and Direct energy reserves all rights. If we do not hear from you within fourteen (14) days, we will be forced to assume your misuse of our intellectual property is continuing and is willful. In a legal action, such willful activities potentially render you subject to claims for actual, treble and punitive damages, in addition to attorney fees.

Our company takes the protection of all of our intellectual property and reputation very seriously. There is no reason, however, to incur costly legal expenses when this matter can be resolved with a few practical steps. We are hopeful you will choose to comply with our request amicably and promptly.

Please contact the undersigned at the email address or phone number identified in this letter regarding the matter above.

Sincerely,

DIRECT ENERGY

By: Michele Lipscomb

Michele Lipscomb
Intellectual Property Paralegal

Attachment

Attachment A



 NEWS

 CONTACT

 (763) 515-6411


ROL AIR
PLUMBING • HEATING • AIR
1-800-AIR-REPAIR

Outside Temperature: 77°
Comfort Club Home: 72°

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With Rol Air Plumbing, Heating and Air, you can have a Comfort Club membership for HVAC only, Plumbing only, or combine Both Services in one membership.

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\$12.95 PER MONTH	\$19.95 PER MONTH	\$29.95 PER MONTH
<ul style="list-style-type: none">• Guaranteed service within 48 hours• 2 precision tune-ups annually*	<ul style="list-style-type: none">• Guaranteed service within 24 hours• 2 precision tune-ups annually*	<ul style="list-style-type: none">• Guaranteed #1 Priority Service• 2 precision tune-ups annually*